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REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-5 and 10-18 are pending in this application. Claims 1, 10, and 15 are independent. The remaining claims depend, directly or indirectly, from claims 1, 10, and 15.

Information Disclosure Statement

The Applicant respectfully requests that the Examiner indicate that he has reviewed the references cited in the Information Disclosure Statement filed on August 27, 2001, by returning an initialed copy of the corresponding PTO-1449 Form.

Objection to Drawings

The drawings were objected to under 37 CFR §1.84 or §1.152. The Applicant respectfully notes that formal drawings filed on January 27, 2004, and respectfully requests the Examiner to indicate whether the filed formal drawings are acceptable.

Double Patenting

In response the office action mailed October 27, 2003, the Applicant submitted, pursuant to the Examiner's suggestion, a terminal disclaimer to overcome the double

patenting rejection with respect to claims 1, 10, 15, and 17. Applicant respectfully requests the Examiner to indicate whether the filed terminal disclaimer is acceptable to overcome the double patenting rejection with respect to claims 1, 10, 15, and 17.

Rejection(s) under 35 U.S.C § 102

Claims 1-18 stand rejected under 35 U.S.C. § 102 as anticipated by iPlanet Directory Server Administrator's Guide (Document ID 816-0799-01) ("iPlanet"). At the outset the Applicant respectfully notes that claims 6-9 have been cancelled by the response received February 2, 2004. Accordingly, the rejection is moot with respect to the cancelled claims.


With respect to the remaining claims, iPlanet is not valid prior art to this application. As evidenced by the attached declaration under 37 C.F.R. § 1.131, the present invention was conceived prior to the effective 102(a) date of iPlanet, and subsequently constructively reduced to practice with due diligence exercised by the inventors. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 13220.022001).

Respectfully submitted,

Date: 7/22/04


Jonathan P. Osha, Reg. No. 33,986
OSHA & MAY L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778

68507_1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David W. BOREHAM, et al. Art Unit : 2177
Serial No.: 09/867,595 Examiner : Kuen S. Lu
Filed : May 29, 2001
Title : METHOD AND SYSTEM FOR DETERMINING A DIRECTORY ENTRY'S
CLASS OF SERVICE BASED ON THE VALUE OF A SPECIFIER IN THE
ENTRY

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

DECLARATION PURSUANT TO 37 CFR §1.131

In connection with the Applicant's Response to the Office Action issued on March 24, 2004, this declaration sets forth the pertinent facts proving conception of the claimed invention prior to **April 2001**.

1. We, David W. Boreham and Peter Rowley, are the listed inventors for U.S. Patent Application 09/867,595 entitled "Method and System For Determining A Directory Entry's Class Of Service Based On the Value of A Specifier In The Entry"
2. We, David W. Boreham and Peter Rowley, conceived the claimed invention prior to at least January 8, 2001, as evidenced by an Internal Invention Disclosure Sheet (see attached) entitled "Method of Determining an Entries Class in a Directory Based on the Value of a Specifier Entry" e-mailed on January 8, 2001, in which we were listed as inventors.
3. We, David W. Boreham and Peter Rowley, diligently worked on the reduction to practice of the invention from, at least, the date established by the Internal Invention

U.S. PATENT APPLICATION 09/867,595
ATTORNEY DOCKET NO.: 13220.022001; 15835

Disclosure Sheet (see attached) until, at least, the date of constructive reduction to practice established by the filing of U.S. Patent Application 09/867,595 filed on May 29, 2001.

4. Mark Smith, while listed as an inventor on the attached Internal Invention Disclosure Sheet, did not make any contribution, individually or jointly, to the subject matter of any claim in U.S. Patent Application 09/867,595 filed on May 29, 2001.

We, David W. Boreham and Peter Rowley, hereby declare that all statements made herein of our own knowledge are true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signed this day 20, of July 2004.

David W. Boreham
David W. Boreham

Signed this day _____, of July _____.

Peter Rowley
Peter Rowley

U.S. PATENT APPLICATION 09/867,595
ATTORNEY DOCKET NO.: 13220.022001; P5835

Disclosure Sheet (see attached) until, at least, the date of constructive reduction to practice established by the filing of U.S. Patent Application 09/867,595 filed on May 29, 2001.

4. Mark Smith, while listed as an inventor on the attached Internal Invention Disclosure Sheet, did not make any contribution, individually or jointly, to the subject matter of any claim in U.S. Patent Application 09/867,595 filed on May 29, 2001.

We, David W. Boreham and Peter Rowley, hereby declare that all statements made herein of our own knowledge are true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Signed this day _____, of July _____.

David W. Boreham

Signed this day 20th, of July 2004.

Peter Rowley
Peter Rowley

----- Original Message -----

Subject: P5836 - Green Sheet - Boreham
Date: Wed, 10 Jan 2001 14:29:56 -0800 (PST)
From: Maria Moore <Maria.Moore@corp.sun.com>
To: andrea.weill@sfbay.sun.com
CC: michael.schallop@sfbay.sun.com,
naren.chaganti@sfbay.sun.com, kristine.bombaci@corp.sun.com,
maria.moore@corp.sun.com

----- Begin Forwarded Message -----

From: andrea.weill@sfbay.sun.com Mon Jan 8 16:59:39 2001
Date: Mon, 8 Jan 2001 16:59:31 -0800 (PST)
Subject: Green Sheet Request
To: undisclosed-recipients;

From: andrea.weill@sfbay
Date Requested: 01/08/01

Type of case: Utility of

File Number: P5836
Country Code:

Serial Number:
Filing Date:

Managing Sun Attorney: MSA
Primary Sun Attorney: Michael Schallop

Division: ALLI
Business Organization: E-Commerce
Project: Directory Server

Technical Category:
Invention Title:
"Method of Determining Class of Service of a Directory Entry in an Indirect Manner"

Inventor(s):
Number 1: David Boreham (Former iPlanet EE)
Number 2: Peter Rowley @ 408-276-4375 (Netscape EE)
Number 3: Mark C. Smith @ 734-944-3477 or 408-276-4747 (Netscape EE)
Number 4:
Number 5:
Number 6:
Number 7:
Number 8:

Bar or Target Date:
Responsible Party: TBD
Preparer: TBD

Remarks

Peter Rowley & Mark Smith are both AOL-Netscape Employees and qualify for the
IDT awards bonus. The Main contact person will be Mark Smith @ his Michigan
office 734-944-3477 or Santa Clara (occasionally) 408-276-4747. TARGET
DATE:
4/08/01

Also NOTE: Naren Chaganti is MSA (His name was not on the pull-down) menu.

Server protocol: HTTP/1.0
Remote host:
Remote IP address: 192.18.184.99

----- End Forwarded Message -----

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)Applicant(s): **David W. BOREHAM, et al.**

Docket No.

13220.022001; P5835

Application No.

09/867,595

Filing Date

05/29/2001

Examiner

Kuen S. Lu

Customer No.

32615

Group Art Unit

2177

Invention: **METHOD AND SYSTEM FOR DETERMINING A DIRECTORY ENTRY'S CLASS OF SERVICE BASED ON THE VALUE OF A SPECIFIER IN THE ENTRY**

JUL 22 2004**PATENT & TRADEMARK OFFICE**

I hereby certify that the following correspondence:

Declaration Pursuant to 37 CFR Section 1.131*(Identify type of correspondence)*

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

July 22, 2004*(Date)***Brenda C. McFadden***(Typed or Printed Name of Person Mailing Correspondence)**(Signature of Person Mailing Correspondence)***EV 526069891US***("Express Mail" Mailing Label Number)***Note: Each paper must have its own certificate of mailing.**